

REMARKS

Claims 26-55 remain in this case.

Claims 26-40 of this divisional application correspond to restricted-out method claim 34-41, 47-51, and 55-56 of the parent patent application, respectively.

Method claims 41-54 are newly added. They are directed to methods discussed at p. 22, lines 11-22 and further discussed in provisional patent application No. 60/121,640, specifically referred to thereat. A copy of the '640 application is attached to this preliminary amendment for the Examiner's convenience. The above amendments to the specification are taken from p. 19, line 34-p. 28 line 26; p. 21, line 25-line 37; and p. 14, line 9-line 13 of the '640 application.

Although the words "incorporated by reference" was not used by **the *pro se* applicant** of the '279 parent application, it is clear that the applicant was making specific reference to the provisional patent application for the teachings of that provisional patent application relating to the method for coating the interstitial pores of the tubular braid and thus incorporated those teachings into the '279 application by such reference. Applicant understands that the entire disclosure of the '640 application was not incorporated by reference; however applicant submit that the specific reference to the specific manufacturing technology was intended to and acted to incorporate that material by reference.

Discussion of Incorporation By Reference

Incorporation by reference into a patent application of written matter found in other patents or printed publications is permitted "for economy, amplification, or clarity of exposition, by means of an incorporating statement clearly identifying the subject matter which is incorporated and where it is to be found." *In re De Seversky* 177 USPQ 144, 146 (CCPA 1973).

The "general incorporation of a U.S. patent by reference in appellant's specification is sufficient to indicate what is likely to be known by persons of ordinary skill in the art." *Ex parte Raible*, 8 USPQ2d 1709-1710 (BPAI 1988). "The issue of compliance with the description requirement, however, is another matter entirely.... The function of the description requirement is to ensure that the applicant had possession, as of the filing date of his application, of the specific subject matter later *claimed* by him. It

is required that the specification describe the invention sufficiently for those of ordinary skill in the art to recognize that the applicant invented the subject matter he now claims....The purpose of incorporation by reference in an application of matter elsewhere written down is for economy, amplification, or clarity of exposition, by means of an *incorporating statement clearly identifying the subject matter which is incorporated and where it is to be found.*" *Ex parte Raible* at 1710.

Using the words "incorporated by reference" will of course be sufficient to incorporate the reference into the patent application. The Manual for Patent Examining Procedure (MPEP) states "Mere reference to another application, patent or publication is not an incorporation of anything therein into the application containing such reference for the purpose of the disclosure required by 35 USC 112, first paragraph. *In re De Seversky*, 474 F.2d 671, 177 USPQ 144, 146 (CCPA 1973)." However, *De Seversky* is a situation in which a continuation in part patent application simply referred to a prior application for priority purposes; the patent application made no other references to the disclosure of the prior application and did not specifically incorporate the prior application by reference. The court held that the mere reference to a prior application for priority purposes was not sufficient to incorporate the prior application by reference.

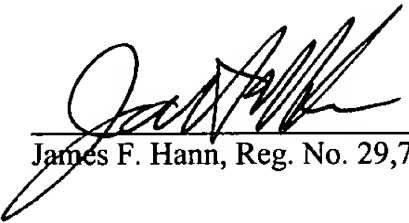
In this case the *pro se* applicant made the following statement in U.S. patent application No. 09/298, 279: "Further, the inventors of the instant invention have disclosed a method of coating the interstitial pores of the tubular braid without adding to the overall wall thickness of the tubular braid. This manufacturing invention is disclosed in pending provisional submission Serial No. 60/121,640." This statement from the '279 application fulfills the stated factor of ensuring that the applicant had possession of the specific manufacturing method invention described in the '640 application. Therefore, those portions of the '640 provisional patent application relating to the method of coating the interstitial pores of the tubular braid have been properly incorporated by reference into the '279 application; to hold otherwise would elevate form over substance and would unfairly create a trap for the *pro se* applicant. Accordingly, the above amendments to the specification involve no new matter.

Applicant submits that the application is in condition for allowance and action to that end is urged. If the Examiner believes a telephone conference would aid the prosecution of this case in any way, please call the undersigned at (650) 712-0340.

Respectfully submitted,

Dated: 12 February 2001.

HAYNES & BEFFEL LLP
P.O. Box 366
Half Moon Bay, California 94019
Phone: 650-712-0340
Fax: 650-712-0263



James F. Hann, Reg. No. 29,719